

REMARKS

Claims 1 and 93-121 are pending. Claims 1, 93-108, 111-115, and 117-121 have been amended. Claims 122 and 123 have been added.

A Declaration Under 37 CFR § 1.131 and a Terminal Disclaimer Under 37 CFR § 1.321(c) have been filed along with this Response.

I. The § 112, Second Paragraph Rejections

The examiner has rejected claims 93-103, 105, 107-113, and 115-121 under U.S.C. § 112, second paragraph. Claims 93-103, 105, 107-108, 111-113, 115, and 117-121 have been amended to address the examiner's concerns. The § 112 rejection of these claims now should be withdrawn.

II. The Examiner's Prior Art Rejections

The examiner has rejected claims 1 and 93-121 under U.S.C. § 102(e) or in the alternative, under U.S.C. § 102(a) over Wilding et al. (U.S. 5,486,335, Wilding I) or Wilding et al. (U.S. 5,498,392, Wilding II). For the reasons explained below, neither Wilding I nor Wilding II constitute prior art with respect to the present invention and, accordingly, the examiner's prior art rejections should be withdrawn.

Declaration Under 37 CFR § 1.131

Applicants' present application was filed on July 24, 1997 (and claims priority back to August 31, 1992, under 35 U.S.C. § 120). Although the effective filing date (May 1, 1992) for both Wilding I and Wilding II is earlier than the effective filing date of the present application (August 31, 1992), the inventors reduced the claimed invention to practice before Wilding I's effective filing date and Wilding II's effective filing date.

As evidenced by the attached Declaration Under 37 CFR § 1.131, the inventors reduced to practice two apparatus (instrument A and instrument B), each of which included a reaction chamber and at least one reactant chamber, at least one channel interconnecting the chambers, a heater configured to heat reactants in the reaction chamber, a temperature controller coupled to the heater and configured to control the temperature of a reaction in the reaction chamber, and a product analysis chamber coupled to the reaction chamber and adapted to analyze reaction products contained in the product analysis chamber, as recited in independent claims 1 and 104. These apparatus were used to amplify preselected polynucleotides in respective samples (see, e.g., Exhibits C and E). In sum, under 37 CFR §

1.131(b), neither Wilding I nor Wilding II constitute prior art, at least with respect to the features recited in the pending claims.

Because each of the examiner's prior art rejections is based at least in part upon Wilding I and Wilding II, all of the examiner's rejections now should be withdrawn.

III. Non-Statutory Double Patenting Rejections

The examiner has rejected claims 1, and 93-121 under the judicially-created doctrine of double patenting over claims 1-90 of U.S. Patent No. 5,639,423. To overcome this rejection, Applicants have filed a terminal disclaimer under 37 CFR § 1.321(c) with this Response.

Applicants note that the filing of any such terminal disclaimer is not an admission that the pending claims are in any way obvious in view of the claims in U.S. Patent No. 5,639,423.

IV. Conclusion

Applicants submit that all of the claims are now in condition for allowance, and now should be allowed.

A petition for extension of time and a check for the required fee are enclosed. Please charge any additional fees or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 7/12/99



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